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### **REMARKS**

This response is intended as a full and complete response to the final Office Action mailed June 1, 2006. In the Office Action, the Examiner notes that claims 1-11, 16, 17, 37, 40, 60, 67-70, 85, 86, 97, 99, 102, 104, 111, 113, 115, 116, 127-129, 137-139, 142-144, 148 and 169-174 are pending and rejected. By this response, all claims continue unamended.

In view of the following discussion, Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Further, Applicants submit that all of the claims satisfy the requirements of 35 U.S.C. §112, ¶1. Thus, Applicants believe that all of these claims are now in allowable form.

It is to be understood that Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

### **REJECTIONS**

#### **35 U.S.C. §112**

The Examiner has rejected claims 70, 138, 142-144, and 148 under 35 U.S.C. §112, ¶1, as failing to comply with the written description requirement. Applicants respectfully traverse the Examiner's rejection.

Claims 70 and 138 explicitly claims "the program is listed in a program guide broadcast to the first terminal by the broadcaster" and "the program guide is broadcast to the first terminal" respectively. This feature is supported by the specification as originally filed. Specifically, page 34, lines 1-3 provides support by stating that individual program guides may be created and downloaded to the specific subscriber at the PC, television and/or the set top terminal. The Examiner further states that there is no support for the details of broadcasting the guide to these locations. The applicants respectfully disagree. From page 32, line 4 to page 82, line 9, the specification as originally filed discloses how the internet web page and other telecommunications media may be used for distributing/broadcasting the program guide and the different

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control signals required for displaying including a first terminal selecting for a second terminal such as on page 34, lines 19-28 where a subscriber orders from the subscriber's own terminal but the receiving terminal is a different terminal. This is accomplished by providing the address and identification number of the receiving terminal. As a result, a person can order from a kiosk and watch the movie at home. The person can also order from home for another subscriber in another location, for example as a gift. Thus, claims 70 and 138 comply with the written description requirement.

Claim 142 is fully supported by the specification as originally filed. The specification discloses a program order from a first terminal the program order containing the address of the first terminal and an address of a second terminal (i.e., page 36, lines 26-29)... generating an authorization code (i.e., page 40, lines 14-17)... sending the generated authorization code to the first and second terminals (i.e., page 36, lines 26-29)... wherein the authorization code received by the first and second terminals provide a code that the first and the second terminals use to decrypt the program (i.e., page 49, lines 11-17). Because there is support for all those limitations listed above, claim 142 complies with the written description requirement.

### 35 U.S.C. §103

#### Claims 1-3, 9, 16, 37, 40, 99, 102, 104, 111, 113, 127-129, and 137-139

The Examiner has rejected claims 1-3, 9, 16, 37, 40, 99, 102, 104, 111, 113, 127-129, and 137-139 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication 2003/0066085 to Boyer et al. (hereinafter "Boyer") in view of U.S. Patent 5,517,502 to Bestler et al. (hereinafter "Bestler"). Applicants respectfully traverse the rejection.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). The Boyer and Bestler references alone or in combination fail to teach or suggest Applicants' invention as a whole.

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Applicants' independent claim 1 recites:

- "1. An apparatus that provides digital broadcast television programs to a subscriber, comprising:  
a first receiver module that receives program data;  
a second receiver module for receiving a local authorization code, wherein the authorization code allows the digital broadcast television programs to be decrypted for viewing;  
a transmitter that sends a program selection to a remote site, wherein the program selection is made from the program data received by the first receiver module and contains the address of the second receiver module; and  
a memory coupled to the second receiver module for storing the received authorization code, wherein when the program selection is received at the remote site, the remote site sends the local authorization code, and wherein the local authorization code is stored in the memory until needed for decrypting the selected program at a future time."

The Boyer reference discloses how to order pay-per-view event. Specifically, the user clicks on a place order button. The user then verifies the user's identity and account status. Once the user's information has been verified, the selected pay-per-view event may be delivered to the user's multimedia system. In a different embodiment, Boyer also teaches internet capable boxes 116, 112 and PC 106 that are able to receive television program information via the internet links. These internet capable boxes may include a separate input for the television signal 118.

Nowhere in the Boyer reference is there any teaching or suggestion of at least Applicants' claimed "a transmitter that sends a program selection to a remote site, wherein the program selection is made from the program data received by the first receiver module and contains the address of the second receiver module".

The Bestler reference fails to bridge the substantial gap between the Boyer reference and Applicants' invention. Specifically, the Bestler reference fails to teach or suggest at least the "a transmitter that sends a program selection to a remote site, wherein the program selection is made from the program data received by the first receiver module and contains the address of the second receiver module" as recited in claim 1.

Bestler discloses a two-way communications network having different types of downstream conditional access (CA) packets, one type of which "includes the public S/N of one or more subscriber terminals together with the associated active and

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received CA and payload key sources, communication bits and authorization levels" (column 8, lines 53-56). Bestler also discloses a subscriber terminal having an upstream transmitter that transmits an upstream data packet which "typically comprises a subscriber identification number and the identification of a particular requested service, such as a particular impulse-pay-per-view (IPPV) television program" (column 7, lines 37-40). However, Bester does not teach a transmitter that sends a program selection to a remote site, wherein the program selection is made from the program data received by the first receiver module and contains the address of the second receiver module.

As such, Applicants submit that independent claim 1 are patentable under 35 U.S.C. §103 over Boyer in view of Bestler. Moreover, independent claims 67, 99, 127, 142 and 169 have relevant limitations similar to those discussed above in regards to claim 1. As such, Applicants submit that independent claims 67, 99, 127, 142 and 169 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 2-3, 9, 16, 37, 40, 102, 104, 111, 113, 128-129, and 137-139 depend, either directly or indirectly, from independent claims 1, 99 and 127 and recite additional features thereof. As such and at least for the same reasons as discussed above, Applicants submit that these dependent claims are also patentable under 35 U.S.C. §103 over Boyer and Bestler.

Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

#### Claims 4 and 17

The Examiner has rejected claims 4 and 17 under 35 U.S.C. §103(a) as being unpatentable over Boyer and Bestler in view of U.S. Patent 5,600,364 to Hendricks (hereinafter "Hendricks '364"). Applicants respectfully traverse the Examiner's rejection. Each ground of rejection applies only to dependent claims, and each is predicated on the validity of the rejection under 35 U.S.C. §103 over Boyer and Bestler.

The Hendricks '364 is disqualified as a reference under 103(c). The application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. They are at least both assigned to

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Discovery Communications, Inc, of Bethesda, MD at the time of the invention was made. Thus, the combination of merely Boyer in view of Bestler would not teach or suggest the claimed invention as a whole.

As such, Applicants submit that claims 4 and 17 are patentable under 35 U.S.C. §103 over Boyer and Bestler in view of Hendricks '364.

Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

#### **Claim 5**

The Examiner has rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Boyer and Bestler in view of U.S. Patent 5,880,769 to Nemirofsky et al. (hereafter "Nemirofsky"). Official Notice has been taken that digital televisions are well known in the art. Applicants respectfully traverse the rejection.

The ground of rejection applies only to dependent claims and is predicated on the validity of the rejection under 35 U.S.C. §103 over Boyer and Bestler. Since the rejection under 35 U.S.C. §103 over Boyer and Bestler has been overcome, as discussed above, and there is no argument put forth by the Office Action that Nemirofsky supplies that which is missing from Boyer and Bestler to render the independent claims obvious, this ground of rejection cannot be maintained.

As such, Applicants submit that claim 5 is patentable under 35 U.S.C. §103 over Boyer and Bestler in view of Nemirofsky.

Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

#### **Claims 6-8, 10, and 11**

The Examiner has rejected claims 6-8, 10 and 11 under 35 U.S.C. §103(a) as being unpatentable over Boyer, Bestler and Nemirofsky in view of U.S. Patent 5,809,204 to Young et al. (hereinafter "Young"). Applicants respectfully traverse the Examiner's rejection.

Each ground of rejection applies only to dependent claims, and each is predicated on the validity of the rejection under 35 U.S.C. §103 over Boyer, Bestler and

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Nemirofsky. Since the rejection under 35 U.S.C. §103 over Boyer, Bestler and Nemirofsky has been overcome, as discussed above, and there is no argument put forth by the Office Action that Young supplies that which is missing from Boyer, Bestler and Nemirofsky to render the independent claims obvious, these grounds of rejection cannot be maintained.

As such, Applicants submit that claims 6-8, 10, and 11 are patentable under 35 U.S.C. §103 over Boyer, Bestler and Nemirofsky in view of Young.

Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

**Claims 67-70, 85, 97, and 169-174**

The Examiner has rejected claims 67-70, 85, 97, and 169-174 under 35 U.S.C. §103(a) as being unpatentable over Boyer in view of Hendricks '364 and Bestler. Official Notice is taken that debiting accounts and charging credit cards is well known in the art. Applicants respectfully traverse the rejection.

For at least the reasons discussed above, independent claims 67 and 169 are patentable under 35 U.S.C. §103 over Boyer and Bestler. In particular, Boyer and Bestler alone or in combination fail to teach or suggest at least Applicants' claimed "a transmitter that sends a program selection to a remote site, wherein the program selection is made from the program data received by the first receiver module and contains the address of the second receiver module".

The Hendricks '364 is disqualified as a reference under 103(c). The application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. They are at least both assigned to Discovery Communications, Inc, of Bethesda, MD at the time of the invention was made. Thus, the combination of merely Boyer in view of Bestler would not teach or suggest the claimed invention as a whole.

Claims 68-70, 85, 97, and 170-174 depend directly or indirectly from independent claims 67 and 169 and recite additional features thereof. As such, for at least the same reasons discussed above, these dependent claims also are patentable under 35 U.S.C. §103 over Boyer in view of Hendricks '364 and Bestler.

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Therefore, the Examiner's rejection should be withdrawn.

**Claims 60 and 115**

The Examiner has rejected claims 60 and 115 under 35 U.S.C. §103(a) as being unpatentable over Boyer and Bestler in view of U.S. Patent 5,734,853 to Hendricks (hereinafter "Hendricks '853"). Applicants respectfully traverse the Examiner's rejection. Each ground of rejection applies only to dependent claims, and each is predicated on the validity of the rejection under 35 U.S.C. §103 over Boyer and Bestler. The Hendricks '853 is disqualified as a reference under 103(c). The application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. They are at least both assigned to Discovery Communications, Inc, of Bethesda, MD at the time of the invention was made. Thus, the combination of merely Boyer in view of Bestler would not teach or suggest the invention as a whole as claimed.

As such, Applicants submit that claims 60 and 115 are patentable under 35 U.S.C. §103 over Boyer and Bestler in view of Hendricks '853.

Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

**Claims 86 and 116**

The Examiner has rejected claims 86 and 116 under 35 U.S.C. §103(a) as being unpatentable over Boyer and Bestler in view of Hendricks '853 and Hendricks '364. Applicants respectfully traverse the Examiner's rejection.

Each ground of rejection applies only to dependent claims, and each is predicated on the validity of the rejection under 35 U.S.C. §103 over Boyer and Bestler. Hendricks '853 and Hendricks '364 are improper prior art under 103(c) for reasons stated above.

As such, Applicants submit that claims 4 and 17 are patentable under 35 U.S.C. §103 over Boyer and Bestler in view of Hendricks '853 and Hendricks '364.

Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

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### Official Notices

The Office Action takes numerous Official Notices. Applicants hereby traverse each Official Notice. The Examiner alleges that apparatus and/or methods taught by certain limitations are well known in the art. However, Applicants believe that these apparatus and/or methods rejected by the Examiner using Official Notice may not be well known within the specific art of the present invention as recited in the pending claims. For example, the allegedly well known limitations may not have motivation to combine with other limitations of the claims in which they are found or in claims form which they depend.

### CONCLUSION

Thus, Applicants submit that all of the claims presently in the application are allowable. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 7/19/06

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